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David J. Joseph

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Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS

Ex parte Ludwig
Appeal No. _____

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Serial No.: 09/410,916
Filed: October 1, 1999
Applicant: Jerome H. Ludwig
Title: STERILIZATION OF FIRE SPRINKLER SYSTEMS
Art Unit: 1744
Examiner: Monzer R. Chorbaji

REPLY BRIEF

Transmitted herewith, in triplicate, is the Reply Brief with respect to the Notice of Appeal filed on August 6, 2003. Appellant believes that no further fees are required in connection with this matter, however, should it be determine otherwise, the Commissioner is hereby authorized to charge Deposit Account No. 23-3000.

Appellant is compelled to respond to certain of the statements, arguments and positions of the Examiner raised in the Examiner's Answer. This reply will take them up in the order in which they arise in the Examiner's Answer.

Grouping of Claims

The Examiner contends that appellant's brief fails to provide reasons in support of the grouping of claims which have been maintained to stand or fall together. However, there is no requirement in 37 CFR §1.192(c)(7) for the appellant to provide reasons. All that is necessary is that a statement be made and appellant has complied in this respect.

Examiner's Answer, Issue 1, Page 5

The Examiner states that "it is not believed credible that they (Ludwig et al) would attempt to clean a system while the sprinkler heads are activated". This position is maintained by the Examiner notwithstanding the fact that the main reference to Ludwig, '536, is directed to liquid chemical cleaning – not sterilizing – let alone with steam, as appellant claims. Furthermore, for reasons asserted in appellant's main brief, the Examiner's superficial treatment of the claimed inventive steps of claims 23-31 does not meet the requirement for evidence to support a case of obviousness. An Examiner's "belief" does not meet this burden.

The Examiner also asserts that the appellant was in error with reference to page 4 of the final office action dated 4/07/2003 and that the Examiner was referring to column 3, line 54 of Ludwig '536, not column 2, line 40 for the use of the second sterilized gas. However, the Board of Appeals will carefully note that even referring to column 3, line 54, that the Examiner's position is not supported for the use of a second sterilized gas because it is only mentioned that one may use "air to

evacuate the system" where "an aqueous chemical cleaning solution" is flushed from the section to be cleaned. This disclosure has nothing to do with a "second sterilized gas" as the Examiner would maintain.

Examiner's Answer, Issue 2

The Examiner again asserts that it is not "believed credible that Ludwig et al would force a cleaning solution into a system that is still filled with water." Again, one must ask what this has to do with the claims here on appeal? Appellant is not claiming a "cleaning solution". The Examiner's reasoning has nothing to do with the claims on appeal.

Examiner Answer, Issue 3

The Examiner again asserts "it is not believed credible that they (Ludwig '536) would attempt to clean a system while the sprinkler heads are activated" and "It is believed reasonable that one of ordinary skill in the art would attach the steam supplying means of Singh in a conventional manner" and, therefore, one would know to inactivate the sprinkler heads. Again, the Examiner substitutes his own thinking, hindsight and assumptions to conclude that claims 23-31 are obvious. There must be factual basis for the Examiner's conclusions as required by *In re Warner* and by the Supreme Court in *Graham v. John Deere* and other authorities relied upon in appellant's main brief.

Examiner's Answer, Issue 4

The Examiner has concluded "that one of ordinary skill in the art would in substituting sterilants from liquid to steam one would (sic) either inactivate or remove and cap the sprinkler heads to accommodate for using a heated source of sterilant." It is critical to understand that Ludwig '536 does not deal with a sterilant. Again the Examiner makes the assumption, but Ludwig '536 does not support the assumption. Ludwig '536, a patent of the named appellant herein, is directed to chemical liquid cleaning that cannot guarantee a sterilized pipe system. The solution is a chemical cleaning solution, not a sterilant! Importantly, none of appellants claimed steps is disclosed in Ludwig '536.

Examiner's Answer, Issue 5

The Examiner, when confronted with the fact that Ludwig '536 deals with temperatures of "10°C to about 80°C" proceeds to go through a convoluted reasoning where he adds the conventional water temperature in pipes, which he contends is about 25°C, to the 80° of Ludwig '536 to arrive at 105°C resulting in the formation of steam! Of course, this is very creative, but it does not make sense. This convoluted reasoning and assumption of the Examiner cannot withstand the requirement to establish a *prima facie* case of unobviousness. Not only does the reference lack the support for the Examiner's conclusion, but it is evidence of the extreme reasoning that the Examiner attempts to use in seeking to obviate the

appealed claims. Indeed, if the Examiner's position were maintained, the Patent Office examination process becomes arbitrary and chaotic.

Examiner's Answer, Issue 6

The Examiner insists that Singh is solving the same problem addressed by appellants claims when in fact Singh employs steam to sterilize a transfer conduit, not a complex water sprinkler system. The Examiner insists, again with reference to column 3, lines 54-55, that Ludwig '536 does teach the purging of sterilant with gas. This reasoning is wrong on two counts because Ludwig '536 is not dealing with sterilant and, furthermore, does not employ any sterile gas or sterilized water for any purpose.

Conclusion

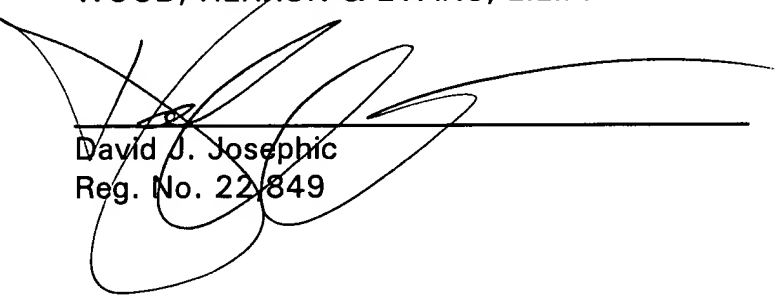
It is inescapable that Ludwig '536 and Singh (the prior art upon which the Examiner relies) do not teach appellant's claimed steps of (a) isolating a section in a fire sprinkler system for delivery of steam, (b) removing water (etc.), (c) using a temperature sensor, (etc), (d) inactivating sprinkler heads for delivery of steam and replacing with temporary fittings, (e) delivering steam to sterilize and (f) returning the section to operation. These steps are required by appellant's claims 24-31. The Examiner is not at liberty to substitute his own belief where he may doubt that the invention is patentable by resorting to speculation, unfounded assumptions and hindsight to reconstruct the appealed claims and supply deficiencies in the factual

basis for his rejection. *In re Warner and Warner*, 379 F.2d 1011, 154 U.S.P.Q. 173 15 177 and 178 (CCPA 1967).

Wherefore, the decision of the Examiner should be reversed, and the decision of the Board of Appeals granting patentability of claims 23-31 is respectfully solicited.

Respectfully submitted,

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